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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,326	02/24/2004	John E. Prevost	8482/011	2325

41129 7590 06/17/2005

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EXAMINER

KOSSON, ROSANNE

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/708,326	<b>Applicant(s)</b> PREVOST ET AL.	
	<b>Examiner</b> Rosanne Kosson	<b>Art Unit</b> 1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on May 25, 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

*llc*

*168*

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8 and 23-27, drawn to a method of producing ethanol from vegetative matter, comprising: milling the vegetative matter, subjecting it to cold solvent extraction, separating it into a starch-containing fraction and an oil-soluble fraction, and producing ethanol from the starch-containing fraction, classified in class 435, subclass 161.
- II. Claims 9-19, drawn to a method of producing ethanol from vegetative matter, comprising: milling the vegetative matter, separating it into a starch-containing fraction and an oil-soluble fraction, subjecting the oil-soluble fraction to solvent extraction to form a second starch-containing fraction and a second oil-containing fraction, and hydrolyzing and producing ethanol from the first and second starch-containing fractions, classified in class 435, subclass 161.
- III. Claims 20-22, drawn to a method of producing ethanol from corn, comprising: subjecting the corn to solvent extraction to produce a first starch-containing fraction and a first oil-soluble fraction, milling the first starch-containing fraction,

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subjecting the milled first starch-containing fraction to solvent extraction to produce a second starch-containing fraction and a second oil-soluble fraction, and producing ethanol from the second starch-containing fraction, classified in class 435, subclass 161.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-III are related in the sense that they are different methods for producing ethanol and one or two oil-soluble fractions from vegetative matter. But, these inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions each recite a different set of steps, as described above. Most notably, in Group I, the vegetative matter is subjected to cold solvent extraction. In Group II, the oil-soluble fraction is subjected to solvent extraction. In Group III, the starch-containing fraction is subjected to solvent extraction. In the instant claims, any solvent may be used in any group. A solvent for extracting an oil-soluble liquid is most likely not the solvent of choice for extracting a starch-containing liquid or solid. Also, Groups II and III do not require cold solvent extraction. Thus, the extraction conditions regardless of solvent may be different. Therefore, these groups are patentably distinct.

Additionally, the search for any one group is not coextensive with the search for any other group, thereby creating an undue burden of search and examination. Burden lies not only in the search of U.S. patents, but in the search for literature and foreign patents and in examination of the claim language and specification for compliance with

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the statutes concerning new matter, distinctness and scope of enablement. Because these inventions are distinct for the reasons given above, restriction for examination purposes as indicated is clearly proper.

**Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosanne Kosson whose telephone number is 571-272-2923. The examiner can normally be reached on Monday-Friday, 8:30-6:00, with alternate Mondays off.

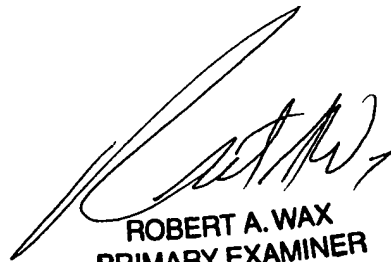
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rosanne Kosson  
Examiner  
Art Unit 1651

rk/2005-06-03



ROBERT A. WAX  
PRIMARY EXAMINER  
*Art Unit 1653*